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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/722,685 | 11/24/2003 | Darrell C. Brett | ExpC:EptaWed | 8337 |

26790 7590 12/10/2007
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| EXAMINER |
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SHAY, DAVID M

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| ART UNIT | PAPER NUMBER |
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3735

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| MAIL DATE | DELIVERY MODE |
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12/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,685

Applicant(s)

BRETT, DARRELL C.

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

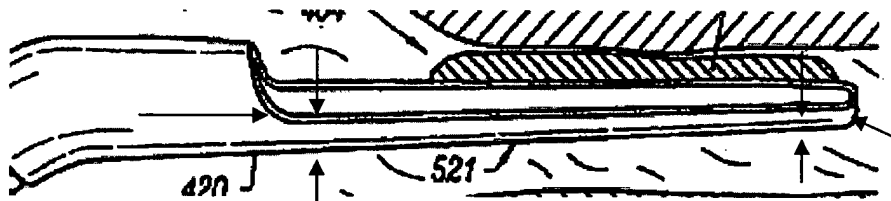
- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Applicant argues that all the claims recite a rounded edge, which is the intersection between the tissue protecting region and the energy application region, and that the tissue protection region is sloped away from the thin leading edge, producing a thicker region that lifts vulnerable tissues. Applicant also asserts that the electrode 14 of Lax et al ('242) is "elongate" and thus cannot read on the claimed subject matter. The examiner must respectfully disagree. Firstly the examiner notes that while the claims refer to a "rounded edge intersection" between "the tissue protecting region and the energy application region" this "round edge intersection" cannot be, as applicant appears to be arguing, construed as the boundary between, e.g. the electrode and the insulating layer of the device, as no illustrated or otherwise disclosed embodiment of the device shows such a configuration (see Figures 6, 12, and 15-28 of the originally filed disclosure), thus this structure must be construed simply as the leading edge of the device which represents the transition between two surfaces. Given this, it is the examiner's view that at least the embodiments of Figures 9, 10, and 14 of the Lax et al ('242) reference show a configuration as claimed. Taking the embodiment of Figure 14 as an example, the intersection of the flat face of the device, which contains the exposed face of the electrode, "the energy application region", and the shaft of the device the, "tissue protection region", is circular and therefore a "round edge intersection" as claimed. Similarly, the edge 46 and the hood 50 of the embodiment shown in Figures 10 and 11 are also clearly rounded in cross-section. As already pointed out, such rounded structures are "thin" at the distalmost point thereof and become thicker in cross-section at more proximal points. Clearly the structures such as the hood and the insulating portion of Figures 10 and 11, and the wedge shaped structure depicted in Figures 14 and 15 are "sloped" and will thus "lift vulnerable tissues away from the site of energy

Art Unit: 3700

application” in the same way as the device of applicant does, if the device of the reference is used in the manner argued by applicant, with respect to the apparatus claims to which the reference is applied. At least the embodiment illustrated in Figures 14 and 15 can be considered “wedge-shaped”, similarly, at least the embodiment illustrated in Figures 10 and 11 can be considered “dome-shaped”.

Turning now to the Underwood et al ('640) reference, applicant argues that the non-active portion of the Underwood et al ('640) device “is flat and does not slope” (emphasis omitted). The examiner must disagree. While the examiner must first note that myriad interpretations of the claims and the Underwood et al ('640) enable the reference to be read on the claims, the examiner will focus on the interpretation already discussed. A portion of Figure 28 is reproduced below:



Undeniably, as is evident from the Figure, and accented by the vertical and horizontal arrows, the feature of the device which is indicated by indicia 521 (“insulating side” see column 32, line 17) is thicker at the portion nearer to the horizontal arrow than at the portion further from the horizontal arrow, thus clearly this region “slopes” as claimed. Further there is clearly a rounded portion (see the diagonally oriented arrow in the reproduced portion of Figure 28 above). The figure also includes an electrode (element 416). Thus the device clearly reads upon the claims, to the extent that the claims read upon the device as disclosed in the originally filed disclosure.

Art Unit: 3700

The remainder of applicants arguments, concerning the lifting that occurs are confusing to the examiner, but appear to be asserting that the non-active portion, i.e. element 521 in Figure 28 of Underwood et al ('640), which is opposite the energy application electrode 416, would lift the tissue towards, rather than away from, the site of energy application. The logical mechanism by which applicant reaches this conclusion escapes the examiner and the examiner respectfully requests that applicant explain more fully the manner in which this believed to occur.

To summarize, since the instant application is a continuation of the parent case, which nowhere recites that the edge of the electrode (optical fiber output, etc) extends to the rounded leading edge of the device forming the tissue protecting region and in fact only illustrates such electrodes (optical fiber outputs, etc) as not extending to any edge of the energy application head, the term "energy application region" must be interpreted to include non-energy transmitting portions of the device (contrary to what applicant seems to be arguing). Since the energy application region must be so defined, the curved portions of the various insulators taught in both the Lax et al ('242) and Underwood et al ('640) references can fairly be said to read on the rounded edge intersection recited in the claims. And since the electrode portions of these devices are situated on surfaces of the insulators which are opposite other exposed surfaces of the insulators and which insulators are of varying width, the other exposed surfaces of the insulators constitute tissue protection regions as claimed.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lax et al ('242).

Art Unit: 3700

The claims read on the device as set forth above.

Claims 1, 2, 4-13, 16, 17, 20, 21, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Underwood et al ('640).

The claims read on the device as set forth above.

Applicant's arguments filed August 27, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and

Art Unit: 3700

Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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PRIMARY EXAMINER
GROUP 330